



Docket No.: 22116-00005-US5
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE UNITED STATES BOARD
OF PATENT APPEALS & INTERFERENCES

Application No.: 09/713,512

Group Art Unit: 1621

Filing Date: November 14, 2000

Examiner: Peter G. O'Sullivan

Appellants: Vermeulen et al

REPLY BRIEF UNDER 37 CFR 1.193

Attention: Board of Patent Appeals and Interferences

Commissioner for Patents

P. O. Box 1450

Arlington, Virginia 22313-1450

Dear Sir:

This is a REPLY BRIEF to the Examiner's Answer dated November 21, 2003.

The rejection of claims 36-41, 44-52, 60 and 61 under 35 U.S.C. 103(a) as being unpatentable over Cherksey et al. is merely based upon the statement "it is expected there will be differences in activity of various steteoisomers in biological systems." This statement by the examiner is not an adequate foundation upon which to sustain a rejection under 35 U.S.C. 103(a). This rationale to support the rejection must fail since insufficient evidence has been presented to substantiate this statement of scientific theory. See *In re Mills* 126 U.S.P.Q. 513 (CCPA 1960) and *Ex parte Levingood*, 28 U.S.P.Q.2nd 1300 (USPTO - Board of Patent Appeals and Interference, 1993).

Moreover, the Examiner's statement seems to be an attempt to rely on per se rules of obvious. As stated in *In re Ochiai*, 37 U.S.P.Q. 2d 1127, 1133 (Fed. Cir. 1995), "reliance on per se rules of obviousness is legally incorrect and must cease." Also see *Ex parte Granneman* 68 U.S.P.Q. 2d 1219 (USPTO - Board of Patent and Interferences, 2003).

Conclusions

In view of our Appeal Brief and the above comments, it is abundantly clear that the Primary Examiner has erred in the rejection of the claims. Accordingly, it is requested that the Board reverse the Examiner's decision and allow the rejected claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication including any extension fees to Deposit Account No. 22-0185.

Dated: 1-15-04
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Respectfully submitted,

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